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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,217	02/13/2004	Carlton J. Sparrell	029258.00036-US01	2491

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COVINGTON & BURLING, LLP  
ATTN: PATENT DOCKETING  
1201 PENNSYLVANIA AVENUE, N.W.  
WASHINGTON, DC 20004-2401

EXAMINER
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FEATHERSTONE, MARK D

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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09/08/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/777,217	<b>Applicant(s)</b> SPARRELL ET AL.	
	<b>Examiner</b> MARK D. FEATHERSTONE	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-11, 16-22 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-11, 16-22, and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Amendment***

Response to Amendment filed 6/20/2008. Claims 1-4, 12-15, 23-26, and 34-35 have been canceled. Claims 5-11, 16-22, and 27-33 are pending.

***Response to Arguments***

Applicant's arguments filed 6/20/2008 have been fully considered but they are not persuasive. Regarding claims 8, 19, and 30, applicant alleges that Rosser fails to teach "wherein the first profile is different from the second profile". Examiner respectfully disagrees. Rosser, figure 1, item 50 teaches a storing of a viewer usage profile within a user set top box. Further, Rosser teaches comparing a viewer usage profile key with a local viewer usage profile, so different insertions can be made on different end users video viewing devices (column 7, lines 51-58). As can be seen in figure 1, the advertisements shown on user screens 56 show different ads (one shows AD1, and one shows LogoB). This results from the different user profiles in each of the user set top devices 44. Rosser clearly shows two distinct set top devices (corresponding to advertising managers) rendering two different advertisements on the same broadcast event.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject

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matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-6, 8-10, 16-17, 19-21, 27-28, and 30-32 are rejected under 35

U.S.C. 103(a) as being unpatentable over “Rosser” in view of “Markman et al, US PG Pub # 20030122966”.

With regard to claim 5, Rosser in view of Markman teaches method of claim 8. Rosser further discloses:

determining the time of rendering of the content stream on the first active rendering device (column 9, line 49-53 this could be on either the first or second of multiple set top devices in a household)

selecting the targeted advertisement additionally responsive to the determined time (column 13, lines 25-36)

With regard to claim 6, Rosser in view of Markman teaches method of claim 8. Rosser further discloses:

identifying a user viewing the content stream on the first active rendering device; and selecting the targeted advertisement additionally responsive to the identified user (column 15, lines 22-28; Rosser describes a number of different ways to identify a specific user of a device (whether that be the first or second of multiple set top devices in a household) in order to target content to that individual).

With regard to claim 8, Rosser discloses:

A home network (Fig. 1 – it is noted by the examiner that the applicant defines a “home area network” as consumer electronic devices connected

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together by electronic cable in paragraph 0006 of the disclosure) comprising a plurality of rendering devices (Figure 1, item 56) and an advertisement manager, a method for selecting a targeted advertisement for insertion in a content stream, the method comprising:

identifying an active rendering device from among the plurality of rendering devices (Column 3, lines 49-53; Rosser teaches a "viewer usage monitor" which records a profile of "viewing habits". In order to view a program, the rendering device must be active)

selecting, responsive to a profile associated with the active rendering device, a targeted advertisement for insertion in a content stream rendered on the active rendering device (column 7, lines 51-60, a particular insertion is selected based on the user profile associated with the particular set top box); inserting the selected targeted advertisement in the content stream (column 13, lines 25-36; Rosser here explains in detail the selection and insertion of a targeted advertisement based on the user profile)

Wherein the selecting step is carried out by the advertisement manager (Rosser does not specifically call his application an "advertisement manager", however in column 13, lines 25-36, it is inherent that the steps are carried out by an application running in the set top box).

Inserting the first targeted advertisement in the first content stream approximately concurrently with either:

a rendering, responsive to a second profile associated with the second active device, of a second targeted advertisement in a second content stream

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rendered on a second active rendering device, wherein the first profile is different from the second profile or a rendering of the second content stream on the second active rendering device (Rosser, figure 1, item 50 teaches a storing of a viewer usage profile within a user set top box. Further, Rosser teaches comparing a viewer usage profile key with a local viewer usage profile, so different insertions can be made on different end users video viewing devices (column 7, lines 51-58). As can be seen in figure 1, the advertisements shown on user screens 56 show different ads (one shows AD1, and one shows LogoB). This results from the different user profiles in each of the user set top devices 44. Rosser clearly shows two distinct set top devices (corresponding to advertising managers) rendering two different advertisements on the same broadcast event.

However, Rosser fails to teach the following feature:

Identifying a second rendering device that is active from among the plurality of rendering devices;

Markman, in his patent application discloses the use of a single STB that provides functionality to multiple TVs (Fig. 3 and paragraph 0045).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine these two references in order to invent a single device that provides the ability to monitor and insert advertisements into a plurality of devices at the same time. The advantage of this would be to reduce hardware cost associated with multiple STBs.

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Claim 9 recites the method of claim 8 with the feature that the second targeted advertisement is selected by the advertisement manager. Rosser further teaches this feature (column 7, lines 51-59; each set top device (corresponding to an advertisement manager) has its own profile and selects the content based on the profile).

Claim 10 recites the method of claim 8 with the added feature that the home area network is located wholly on the customer premises side of a demarcation point marking a separation from a carrier network (As stated in the claim 3 rejection, this feature is disclosed by Rosser in Figure 1, items 40 and column 7, lines 21-24).

Claims 16-17 are the apparatus to perform method claims, and 5-6, and are analyzed and rejected accordingly.

Claims 19-21 are the apparatus to perform method claims 8-10, and are analyzed and rejected accordingly.

Claims 27-28 are the computer readable medium with instructions to perform method claims 5-6, and are analyzed and rejected accordingly.

Claims 30-32 are the computer-readable medium with the instructions to perform method claims 8-10, and are analyzed and rejected accordingly.

3. Claims 7, 18, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser in view of Markman, in further view of Ward III et al, US PG Pub #20020013941.

With regard to claim 7, Rosser, in view of Markman teaches:  
The method of claim 8 (see claim 8 rejection)

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However, Rosser in view of Markman fails to teach the following feature:

Receiving a user-entered program-control command; and

Selecting the first targeted advertisement additionally responsive to the received user-entered program-control command

Ward III, in his application, teaches the ability for a user to set controls to prevent viewing of content based on a variety of criteria, including rating, time, channel, and cost. (paragraph 0044)

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Rosser with the teachings of Ward to invent a system that targeted advertisements (whether that be the first or second set top device as disclosed by Rosser) to viewers based partially on the program controls input by the viewer. The advantage of this would be to prevent inappropriate commercial content from being displayed to an unintended audience.

Claim 18 is the apparatus to perform method claim 7, and is analyzed and rejected accordingly.

Claim 29 is the computer-readable storage medium to perform method claim 7, and is analyzed and rejected accordingly.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**



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See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK D. FEATHERSTONE whose telephone number is (571)270-3750. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F US Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Koenig can be reached on (571) 272-7296. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Featherstone/ - Assistant Examiner

/Andrew Y Koenig/  
Supervisory Patent Examiner, Art Unit 2623